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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/[illegible]007	08/04/97	BERSCHEID R	[illegible]-203-15[illegible]

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EXAMINER	
SHIPPEN, M	

ART UNIT	PAPER NUMBER
1631	13

DATE MAILED: 12/30/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/860,007	Applicant(s) Berscheid et al.
	Examiner Michael L. Shippen	Group Art Unit 1621

☒ Responsive to communication(s) filed on *Oct 5, 1998* .

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *three* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *8 and 13-42* is/are pending in the application.

Of the above, claim(s) *19, 20, 28-32, and 36-42* is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *8, 13-18, 21-27, and 33-35* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Election/Restrictions

Applicants' traversal of the withdrawal of claims 19 and 20 has been carefully considered. Applicants point out that the compounds (and products) of these claims are within the purview of the elected compounds of formula I. While these claims read upon the elected group, they do not read upon the elected species. See M.P.E.P.§§ 809.02(c) and 803.02. Since there is no allowable generic claim embracing the nonelected species, withdrawal thereof is proper.

Claims 19, 20, 28-32 and 36-42 stand withdrawn from consideration as not reading upon the elected species, 37 C.F.R. § 1.142(b). A complete response to the final rejection must include cancellation of non-elected claims or other appropriate action (37 C.F.R. § 1.144) M.P.E.P. § 821.01.

Claim Rejections - 35 USC § 112

Claims 15 and 26 are rejected under 35 U.S.C. § 112, first and second paragraphs. The process steps as recited in the claims will not afford products wherein R_1 is not hydrogen (claim 15) or products wherein n is 2 (claims 15 and 26). A process for carrying out the claimed process to afford such products is not disclosed nor enabled in the specification as filed. If one has to carry out additional process steps to obtain such products, such critical reaction steps and conditions are not set forth in the claim which makes the claim to fail to particularly point out the claimed invention. Page 9 of the specification is noted. While page 9 teaches a method of preparing compounds wherein

n is 2, the process of page 9 is not being claimed here. If the claims are intended to read on the process steps of page 9, the claims fail to particularly point this out. As to the claims presently read, they read on a process where products wherein n is 2 are obtain by the process steps specifically recited in the claims which is not enabled. Page 9 of the specification does this address the issue of how one obtains products by the claimed process wherein R_1 is not hydrogen.

Claim 27 is rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out the claimed invention. The phrase "uninterrupted or interrupted by oxygen and/or sulfur atoms" with respect to R_3 to R_7 does not make any sense. Is this in reference to the thiocyanate group or something else?

Claim Rejections - 35 USC § 103

Claims 8, 14-18, 21-25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hopp (USP 4,110,430) for reasons of record. The tables set forth in the specification have been carefully considered but not found persuasive of patentability. The tables do not make any direct comparison of the prior art compounds with the structurally closest claimed compounds. As such there is no evidence that the claimed compounds possess unexpectedly superior properties or properties different from the prior art. It is of no moment that the prior art does not teach all the same activity or utility for the prior art compounds as that described by applicants. The skilled artisan need possess only some motivation to modify the prior art compound, and that such motivation need not coincide with the one driving an applicant. The motivation is related to the uses one skilled in

the art would expect that compound to have upon analyzing the prior art. That an applicant comes upon a use of a compound that is not taught by the prior art does not speak to the compound's nonobviousness. *In re Shetty*, 195 USPQ 753 (CCPA 1977); *In re Lintner*, 173 USPQ 560 (CCPA 1972); *In re Hoch*, 166 USPQ 406 (CCPA 1970).

Claims 8, 13-18, 21-25, 37 and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sipos (USP 4,321,257) for reasons of record. The tables set forth in the specification have been carefully considered but not found persuasive of patentability. The tables do not make any direct comparison of the prior art compounds with the structurally closest claimed compounds. As such there is no evidence that the claimed compounds possess unexpectedly superior properties or properties different from the prior art. It is of no moment that the prior art does not teach all the same activity or utility for the prior art compounds as that described by applicants. The skilled artisan need possess only some motivation to modify the prior art compound, and that such motivation need not coincide with the one driving an applicant. The motivation is related to the uses one skilled in the art would expect that compound to have upon analyzing the prior art. That an applicant comes upon a use of a compound that is not taught by the prior art does not speak to the compound's nonobviousness. *In re Shetty, supra*; *In re Lintner, supra*; *In re Hoch, supra.*

Claim 15 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hafner (USP 4,968,668) in view of Vogel ("A Textbook of Practical Organic Chemistry") for reasons of record.

In response to applicants' argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a

sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 170 USPQ 209. In response to applicants' argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 5 USPQ2d 1596 and *In re Jones*, 21 USPQ2d 1941. As pointed out in the last Office action, one would be motivated to prepare a necessary starting materials by known, standard methods of synthesis. Applicants' assertion that the products possess unexpected properties has been considered but not found persuasive. The properties of the products are not the result of the method of preparation but rather the structural features of the products themselves regardless of the method of preparation.

Conclusion

THIS ACTION IS MADE FINAL. Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the

mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Michael L. Shippen** whose telephone number is **(703) 308-4635**. The Examiner's normal tour of duty is 8:00 AM to 4:30 PM. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(703) 308-1235**. The Examiner's supervisor, **Gray Geist**, may be reached at **(703) 308-1701**. The official group FAX machine number is **(703) 308-4556**.

MShippen
December 30, 1998

MICHAEL L. SHIPPEN
PRIMARY EXAMINER
ART UNIT 1621